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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,365	02/19/2002	Toshiyuki Mitsubori	325772028000	1530

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EXAMINER

LAM, ANDREW H

ART UNIT PAPER NUMBER

2624

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/076,365

Applicant(s)

MITSUBORI ET AL.

Examiner

Andrew H. Lam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-33 is/are allowed.
- 6) ☒ Claim(s) 1-19, 22-23, 34-38 is/are rejected.
- 7) ☒ Claim(s) 20-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

DOUGLAS Q. TRAN
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 2/19/02.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: a few examples are on paragraph 0066, scanner 13, paragraph 0073, digital copy machine 14, paragraph 0074, scanner 15. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Allowable Subject Matter

Claims 24-33 are allowed.

Claims 20 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed invention is a computer related invention. The Computer-Implemented Invention Guidelines issued by the U.S. Patent and Trademark Office describe the procedures for examining such inventions.

The first step is to determine whether the invention as defined by the claims falls within one of the three following categories of unpatentable subject matter: (1) Functional descriptive material such as a data structure per se or a computer program per se, (2) Non-functional descriptive material such as music, literary works or pure data, embodied on a computer readable medium; or (3) A natural phenomenon such as energy or magnetism. The invention as defined by the claims is not a natural phenomenon or pure data, however, it is a computer program per se, which does not mount/store on any computer-readable medium; therefore, these claims are rejected for non-statutory basis.

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Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The program claimed is merely a set of instructions per se. Since the computer program is merely a set of instructions not embodied on a computer readable medium to realize the computer program functionality, the claimed subject matter is non-statutory. The examiner recommends the applicant to replace " program" with "computer executable instructions embodied on a computer readable medium" so it compliances with 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16 and 34-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Tabata et al (U.S. Patent No. 6,537,324) hereinafter Tabata.

Regarding claim 1, Tabata discloses a data processing device (fig. 1, terminal equipment 70) connected to a server computer (fig. 1, file server 20) via a network (fig. 1, network) comprising: an image reader (fig. 1, scanner 60) for obtaining an image data by reading a document image, wherein the document is printed based on a file published on the network by the server computer (col. 5,

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lines 40-41, scanner is used to read the paper medium 201); an extracting means (fig. 1, scanner 60) for extracting location information that indicates the location of the file from the image data (col. 5, lines 45-47, scanner 60 is used to read selection information and linkage information from the medium form 201); a transfer requesting means (fig. 1, terminal equipment 70) for requesting the server computer to transfer the file based on the location information extracted by the extracting means (col. 5, lines 48-51, terminal equipment 70 is used to retrieve appropriate correlated information file from the file server base on the extraction done by the scanner 60); a receiving means (fig. 1, terminal equipment 70) for receiving a file transferred by the server computer (col. 5, lines 51-53, file 81 is retrieved by the network terminal equipment 70); and a transmitting means (fig. 13 server 20A) for transmitting the image data to a specific destination if it fails to obtain the file from the server computer based on the location information (col. 20, lines 53-62, a determination step is made as to whether the versions match each other---when the versions do not match the file server 20A transfer the updated medium form 301 to be outputted on the screen).

Regarding claim 2, Tabata discloses a data processing device according to claim 1, further comprising: a printer (fig. 1, printer 80) for printing images based on image data, wherein the specific destination is the printer (col. 5, lines 51-54, the printer 80 is used to print the file 81 on recording paper).

Regarding claim 3, Tabata discloses a data processing device according to claim 1, wherein the specific destination is another device (col. 5, lines 54-57, the output terminal 90 can be used to display the file 81).

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Regarding claim 4, Tabata discloses a data processing device according to claim 1, wherein the extracting means extracts the location information by applying a character recognition process to character images existing in a certain area of the image data (fig. 5 mark 51, the marked area 51 is recognized by the scanner 60).

Regarding claim 5, Tabata discloses a data processing device according to claim 1, wherein the location information is a URL (col. 10, line 46-50, URL is used as an address for each correlated information file).

Regarding claims 6-11 the claims recite limitations that are similar and in the same scope of invention as to those in claims 1-5 above and combination thereof; therefore, claims 6-11 are rejected for the same rejection rationale/basis as described in claims 1-5.

Regarding claim 12, Tabata discloses a data processing device (fig. 1, terminal equipment 70) connected to a server computer (fig. 1, file server 20) via a network (fig. 1, network) comprising: an image reader (fig. 1, scanner 60) for obtaining a first image data by reading a document image (col. 5, lines 40-41, scanner is used to read the paper medium 201), wherein the document is printed based on a file published on the network by the server computer; an extracting means (fig. 1, scanner 60) for extracting location information that indicates the location of the file from the first image data (col. 5, lines 45-47, scanner 60 is used to read selection information and linkage information from the medium form 201); a transfer requesting means (fig. 1, terminal equipment 70) for requesting the server computer to transfer the file based on the location information

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extracted by the extracting means (col. 5, lines 48-51, terminal equipment 70 is used to retrieve appropriate correlated information file from the file server base on the extraction done by the scanner 60); a receiving means (fig. 1, fig. 1, terminal equipment 70) for receiving a file transferred by the server computer (col. 5, lines 51-53, file 81 is retrieved by the network terminal equipment 70); a data generating means (fig. 1, printer 80, is used to print the file 81 which is retrieved from the file server 20) for generating a second image data based on the file received by the receiving means; a judging means (fig. 1, file server 20) for judging whether the second image data agrees with the first image data (col. 20, lines 44-45, determination is made as to whether the versions match each other or not as a result of verification between the version); and a notifying means (fig. 1, file server 20) for notifying the user of the fact of the disagreement if it is judged by the judging means that the second image data does not agree with the first image data (col. 20, lines 52-55, file server sends a message notifying the user that the version do not match).

Regarding claim 13, Tabata discloses a data processing device according to claim 12, wherein the notifying means further receives an instruction specifying either the first image data or the second image data by the user, and the data processing device is further comprising a printer for printing images based on image data and a transmitting means for transmitting the first image data or the second image data to the printer in accordance with the instruction by the user (col. 20, lines 59-62).

Regarding claim 14, Tabata discloses a data processing device according to claim 12, wherein the notifying means further receives an instruction specifying either the first image data or the second image data by the user, and the data processing device is further comprising a transmitting means for transmitting the first image data or the second image data to another device in accordance with the instruction by the user (col. 20, lines 59-62).

Regarding claim 15, Tabata discloses a data processing device according to claim 12, wherein the extracting means extracts the location information by applying a character recognition process to character images existing in a specific area of the first image data (fig. 5 mark 51, the marked area 51 is recognized by the scanner 60).

Regarding claim 16, Tabata discloses a data processing device according to claim 12, wherein the location information is a URL (col. 10, line 46-50, URL is used as an address for each correlated information file).

Regarding claim 34, Tabata discloses a data processing device (fig. 1, terminal equipment 70) connected to a server computer (fig. 1, file server 20) via a network (fig. 1, network) comprising: an image reader (fig 1, scanner 60) for obtaining a first image data by reading a document image, wherein the document is printed based on a file published on the network by the server computer (col. 5, lines 40-41, scanner is used to read the paper medium 201); an extracting means (fig. 1, scanner 60) for extracting location information that indicates the location of the file from the first image data (col. 5, lines 45-47, scanner 60 is used to read selection information and linkage information from the medium form

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201); a transfer requesting means (fig. 1, terminal equipment 70) for requesting the server computer to transfer the file based on the location information extracted by the first extracting means (col. 5, lines 48-51, terminal equipment 70 is used to retrieve appropriate correlated information file from the file server based on the extraction done by the scanner 60); a receiving means for receiving a file transferred by the server computer (col. 5, lines 51-53, file 81, is retrieved by the network terminal equipment 70); a data generating means for generating a second image data based on the file received by the receiving means (fig. 1, printer 80, is used to print file 81); a judging means for judging whether the document image is a color or monochromatic image based on the first image data (col. 7, lines 20 –30); and a transmitting means for transmitting the first image data to a specific destination if it is judged by the judging means that the document image is a color image, while transmitting the second image data to the specific destination if it is judged that the document image is a monochromatic image (col. 7, lines 20 –30, based on the type of file the correct print is need to output the document , i.e., monochromatic or color printer).

Regarding claim 35, Tabata discloses a data processing device according to claim 34, further comprising: a printer for printing images based on image data, wherein the specific destination is the printer (fig. 1, printer 80, is the specify printer for document 81).

Regarding claim 36, Tabata disclose a data processing device according to claim 34, wherein the specific destination is another device (fig. 1, printer 40 can also be used to print document 81).

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Regarding claim 37, Tabata discloses a data processing device according to claim 34, wherein the extracting means (fig. 1, scanner 60, is used to OCR file 201) extract the location information by applying a character recognition process to character images existing in a certain area of the first image data (fig. 5, mark 51, the marked area 51 is recognized by the scanner 60)

Regarding claim 38, Tabata discloses a data processing device according to claim 34, wherein the location information is a URL (col. 10, lines 46-50, URL is used as an address for each correlated information file).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-19 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata in view of Melen et al (U.S. Patent No. 6,263,121) hereinafter Melen.

Regarding claim 17, Tabata discloses a data processing device (fig. 1, terminal equipment 70) connected to a server computer (fig. 1, file server 20) via a network (fig. 1, network) comprising: an image reader (fig. 1, scanner 60) for obtaining a first image data by reading a document image (col. 5, lines 40-41, scanner is used to read the paper medium 201), wherein the document is printed based on a file published on the network by the server computer; a first

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extracting means (fig. 1, scanner 60) for extracting location information that indicates the location of the file from the first image data (col. 5, lines 45-47, scanner 60 is used to read selection information and linkage information from the medium form 201); a receiving means (fig. 1, terminal equipment 70) for receiving a file transferred by the server computer (col. 5, lines 49-50, terminal equipment 70 is a retrieving unit for retrieving appropriate correlated information file from the file server); a storage device for storing the file received by the receiving means (fig. 1, terminal equipment 70, is a computer therefore it is implicit that it has a some sort of magnetic or optic device to storage information or data); a transfer requesting means (fig. 1, terminal equipment 70) for requesting the server computer to transfer the file based on the location information extracted by the extracting means (col. 5, lines 48-51, terminal equipment 70 is used to retrieve appropriate correlated information file from the file server base on the extraction done by the scanner 60); a receiving means (fig. 1, fig. 1, terminal equipment 70) for receiving a file transferred by the server computer (col. 5, lines 51-53, file 81 is retrieved by the network terminal equipment 70); a data generating means (fig. 1, printer 80, is used to print the file 81 which is retrieved from the file server 20) for generating a second image data based on the file received by the receiving means; a judging means (fig. 1, file server 20) for judging whether the second image data agrees with the first image data (col. 20, lines 44-45, determination is made as to whether the versions match each other or not as a result of verification between the version); and a notifying means (fig. 1, file server 20) for notifying the user of the fact of the

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disagreement if it is judged by the judging means that the second image data does not agree with the first image data (col. 20, lines 52-55, file server sends a message notifying the user that the version do not match).

Tabata does not disclose expressly a second extracting means for extracting printing date that indicates the date when the document was printed from the first image data; a file retrieving means for retrieving a file that has the same location information as the location information extracted from the first image data and was received later than the printing date extracted from the first image data; and a data generating means for generating a second image data based on the file retrieved by the file retrieving means.

Melen discloses a system for archiving and retrieving documents wherein the document is archive based on attributes (see fig. 3). Furthermore, Melen discloses that the retrieving of the document can be done based on a pointer file wherein the pointer file display to the user the dates of all the version of the document (see fig. 4).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Tabata in view of Melen because by having a device that can extract the date of a document and display all of the version dates of that document to the user will ensure that the user can select the latest version to be printed.

Regarding claim 18, the combination [Tabata] discloses a data processing device according to claim 17, further comprising: a printer for printing images based on image data (fig. 1, printer 40); and a transmitting means (fig. 1, file

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server 20) for transmitting the second image data to the printer if the file retrieving means succeeds in retrieving the file, and transmitting the first image data to the printer if the file retrieving means fails in retrieving the file (it would be obvious to print the scanned document if the user can not retrieve the document via network).

Regarding claim 19, the combination [Tabata] discloses a data processing device according to claim 17, further comprising: a transmitting means for transmitting the second image data to another device if the file retrieving means succeeds in retrieving the file (fig.1, the file server 20 can transmit the second image data to any printer such as printer 40 or printer 80), and transmitting the first image data to the another device if the file retrieving means fails in retrieving the file (it would be obvious to print the scanned document if the user can not retrieve the document via network, and that the scanner and the printer is two separate devices).

Regarding claim 22, the combination [Melen] discloses a data processing device according to claim 17, wherein the first and second extracting means extract the location information and printing date respectively by applying a character recognition process to character images existing in a certain area of the first image data (fig. 3, the file 210, OCR to extract attributes such as date field).

Regarding claim 23, the combination [Melen] discloses a data processing device according to claim 17, wherein the location information is a URL (col. 4, lines 20-25).

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew H. Lam whose telephone number is (571) 272-8569. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DOUGLAS Q. TRAN
PRIMARY EXAMINER

